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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,824	02/06/2002	Charles E. Romano JR.	83245LMB	8825

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EXAMINER	
SCHWARTZ, PAMELA R	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/068,824	ROMANO, CHARLES E.	
	Examiner	Art Unit	
	Pamela R. Schwartz	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 February 2004* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) *23-36* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22 and 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-37* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *3* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Applicant is advised that should claims 2 be found allowable, claim 37 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

2. EP 1110745, submitted by applicants, has now been considered.

3. Applicant's election with traverse of Group I in Paper No. 20040202 is acknowledged. The traversal is on the ground(s) that the claims include some of the same recitations and that due to this commonality, coextensive searches would not prove burdensome. This is not found persuasive because the searches are not coextensive and the additional search required to examine both groups of claims together would prove burdensome. In addition, the basis for the restriction as set forth in the last office action is proper. Finally, method claims of appropriate scope will be rejoined for allowance.

The requirement is still deemed proper and is therefore made FINAL.

4. Claims 1-3, 7-15,19-22 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al. (5,478,631) for reasons of record and for reasons given below.

5. Claims 1, 2, 4-6 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al. as applied to claims 1-3, 7-15 and 19-22 above, and further in view of Tomizawa et al. (6,224,971) for reasons of record and for reasons given below.

6. Claims 1 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawano et al. as applied to claims 1-3, 7-15, 19-22 above, and further in view of Ueda et al. (EP 791,475) for reasons of record and for reasons given below.

7. Applicant's arguments filed February 2, 2004 have been fully considered but they are not persuasive. Applicants argue that Kawano et al. fail to teach a "laminate adhesion promoting absorbing hydrophilic overcoat." The examiner disagrees. While Kawano et al. does not refer to any layer in this manner, the term "laminate adhesion promoting absorbing hydrophilic" is a list of properties that are attributed to the overcoat layer in the instant claims. Since the outermost layer of Kawano et al. may be formed from acetoacetylated polyvinyl alcohol, it inherently possesses these properties (see col. 7, line 3 to col. 8, line 60). Applicants argue that Kawano et al. "fails to mention the property of laminate adhesion." The prior art need not use materials or layer to solve the problems or to have the properties set forth by applicants. Applicants require the layer to promote "laminate adhesion." This is a property any layer has if it is successfully laminated to adjacent layers. Therefore, it is clearly a property which the uppermost layer of Kawano et al. possesses.

Kawano et al. considered numerous properties in determining compositions of their layers, one of which was successful adhesion to adjacent layers (see col. 8, lines

9-13 and 44-51). The recitation at col. 8 identifies adhesion of the layers as a property that Kawano et al. had identified and were aware of. Therefore, they would have chosen the composition of each layer so that adhesion to adjacent layers was successful. It is unnecessary to modify the reference to produce laminate adhesion.

Contrary to applicants' arguments, Kawano et al. disclose acetoacetylated polyvinyl alcohol as a material for use in these layers as a water soluble high polymer. This is a derivatized polyvinyl alcohol as instantly claimed.

Applicants also argue that Kawano et al. require the presence of an amphoteric latex. This is unpersuasive since applicants use open claim language and may have an amphoteric latex present in their claimed invention.

Applicants argue further that their examples demonstrate unexpected results when derivatized polyvinyl alcohol is used in lies of non-derivatized polyvinyl alcohol or a mixture of non-derivatized polyvinyl alcohol and polyethylene oxide copolymer. These showings are not persuasive because the examples do not vary only the polyvinyl alcohol. In each of examples 1-4, the derivatized polyvinyl alcohol is used along with another material (surfactants in example 1, polyurethane dispersion in examples 2 and 3, and vinyl copolymer in example 4). These materials were not present in the comparative examples, so there is no comparison in which the polyvinyl alcohol alone was varied. There is no showing demonstrating that unexpected results are obtained merely by changing from non-derivatized to derivatized polyvinyl alcohol.

Applicants' arguments concerning the secondary art appear to be cumulative and directed to the alleged failings of Kawano et al. These arguments are unpersuasive for the reasons set forth above.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
April 13, 2004